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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
GILLIGAN, CHRISTOPHER L	
ART UNIT	**PAPER NUMBER**
3626	

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08/27/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/067,181	MARTIN ET AL.	
	Examiner	Art Unit	
	Luke Gilligan	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 September 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Response to Amendment

1. In the amendment filed 9/21/06, the following has occurred: claims 1-4 and 8-10 have been amended and claims 14-19 have been added. Now, claims 1-19 are presented for examination.

2. The rejections under 35 U.S.C. 112 are withdrawn by the Examiner based on changes made by Applicant to the claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-3, 6-9, 12-14, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newman et al., U.S. Patent No. 6,035,276 in view of Turner, **Bexar, Medical Society taking credentialing unit national** (hereinafter Bexar, paragraphs numbered by Examiner) (both references cited in IDS, filed 5/6/02).

5. As per claim 1, Newman teaches a method of ensuring current information when credentialing information has been obtained from a healthcare provider, the method comprising: obtaining a release of associated credentialing information, between recredentialing periods, from an associated healthcare provider (see column 3, lines 11-20, the Examiner interprets the initial universal application from, completed by a physician desiring to use the system, to be a form of "release" as recited in the claim; the Examiner also interprets the periodic updating of credentialing information to include occurrences "between recredentialing periods" as claimed); updating the associated credentialing information with new information, the new information

being collected by affiliated associations, being at least one of the group recited (see column 2, lines 26-32 and column 5, lines 35-54); and evaluating the new information (see column 5, lines 50-52).

6. Although Newman teaches that new information can be obtained from "affiliated associations" (see column5, lines 45-49), the reference does not explicitly teach that the new information is collected by an associated insurance entity. However, Bexar teaches obtaining new information for credentialing by an associated insurance entity (see paragraphs 6-8, 14, and 20-21). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate an insurance entity for collecting information as described by Bexar into the system of Newman. One of ordinary skill in the art would have been motivated to incorporate an insurance entity in this way for the purpose of taking advantage of the overlap in information utilized by both malpractice insurance organizations and credentialing organizations (see paragraphs 20-21 of Bexar).

7. Although Newman does not explicitly teach performing certain steps "for the purpose of underwriting or renewing liability insurance," this is merely an intended use of the claimed invention. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Additionally, Bexar suggests utilizing credentialing information for the purpose of underwriting liability insurance (see paragraphs 20-21). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to perform certain steps "for the purpose of underwriting or renewing liability insurance" for the purpose of taking advantage of the overlap in information utilized by both malpractice insurance organizations and credentialing organizations (see paragraphs 20-21 of

Bexar).

8. Claims 2-3 and 14 recite substantially similar limitations to those already addressed in claim 1 and, as such, are rejected for similar reasons as given above.

9. As per claim 6, Newman in view of Bexar teaches the method of claim 2 as described above. Newman further teaches obtaining a release of associated credentialing information from an associated healthcare provider, the release being obtained via a global computer network (see column 3, lines 11-20 and column 6, lines 30-37).

10. As per claim 7, Newman in view of Bexar teaches the method of claim 6 as described above. Newman further teaches reviewing the associated credentialing information, the information being reviewed via the global computer network (see column 6, lines 30-37).

11. Claims 8-9 ,12-13 and 17 recite substantially similar apparatus limitations to method claims 2-3 and 6-7 and 14 and, as such, are rejected for similar reasons as given above.

12. Claims 4-5, 10-11, 15-16 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newman et al., U.S. Patent No. 6,035,276 in view of Turner, **Bexar, Medical Society taking credentialing unit national** and further in view of Business Wire, **PHICO Capital Markets Debuts On-Line Insurance Quotes for Physician Malpractice Coverage** (hereinafter PHICO, paragraphs numbered by Examiner).

13. As per claim 4, Newman in view of Bexar teaches the method of claim 2 as described above. Newman further teaches evaluating the new information (see column 5, lines 50-52). Newman does not explicitly teach generating an insurance premium quote. PHICO teaches generating an insurance premium quote for malpractice insurance (see paragraph 1). Bexar further suggests utilizing credentialing information to generation malpractice insurance policies

(see paragraphs 20-21). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this functionality into the combined system of Newman and Bexar. One of ordinary skill in the art would have been motivated to add this functionality for the purpose of taking advantage of the overlap in information utilized by both malpractice insurance organizations and credentialing organizations (see paragraphs 20-21 of Bexar).

14. As per claim 5, Newman in view of Bexar and PHICO teaches the method of claim 4 as described above. Newman does not explicitly teach generating a medical malpractice insurance policy based on the new information. Bexar further teaches underwriting malpractice insurance based on information from a credentialing organization (see paragraph 21). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the system of Newman. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of taking advantage of the overlap in information utilized by both malpractice insurance organizations and credentialing organizations (see paragraphs 20-21 of Bexar).

15. Claims 15-16 contain substantially similar limitations to those already addressed in claim 5 and, as such, are rejected for similar reasons as given above.

16. Claims 10-11 and 18-19 recite substantially similar apparatus limitations to method claims 4-5 and 15-16 and, as such, are rejected for similar reasons as given above.

Response to Arguments

17. In the remarks filed 9/21/06, Applicant argues in substance that (1) the applied references fail to suggest the combination proposed in the Office Action; (2) there is no teaching in Newman to suggest that filling out the universal application is a release for the purpose of

underwriting or renewing liability insurance; (3) the Bexar reference makes no mention of using information from a credentialing application to underwrite insurance.

18. In response to Applicant's argument (1), it is respectfully submitted that a specific teaching that suggests the proposed combination is not required for a finding of obviousness. KSR, 127 S.Ct. 1741, 82 USPQ2d at 1396. The Examiner has applied the teachings of the references in a manner that does not change their respective functions and which yields predictable results. Therefore, the claimed subject matter would have been obvious to one of ordinary skill in the art at the time of the invention.

19. In response to Applicant's argument (2), it is respectfully submitted that one of ordinary skill in the art would have recognized that a physician submitting a credentialing application to a credentialing entity is "releasing" the information contained therein to the credentialing entity. In addition, the phrase "for the purpose of underwriting or renewing liability insurance" is merely a statement of intended use and does not distinguish the claimed invention from the prior art in terms of patentability. Moreover, it appears that Applicant's have only considered the teachings of Newman as applied to this limitation, while the rejection is based upon the combined teachings of Newman and Bexar. Given the fact that the Bexar reference suggests utilizing credentialing information in the underwriting of medical malpractice insurance (see paragraphs 20-21), it would have been obvious to one of ordinary skill in the art to obtain a release "for the purpose of underwriting or renewing liability insurance."

20. In response to Applicant's argument (3), although the majority of the reference is directed to the credentialing operations of Bexar, the final two paragraphs clear disclose that medical malpractice insurance provider (Texas Medical Liability Trust) partnered with Bexar because the credentialing operations complement their insurance operations, the is a lot of overlap in information between the two entities, and by combining their services, it save

physicians time. It is respectfully submitted that this would clearly have suggested to one of ordinary skill in the art at the time of the invention to combine the services of a credentialing entity with the services of a malpractice insurance provider.

Conclusion

21. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

22. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke Gilligan whose telephone number is (571) 272-6770. The examiner can normally be reached on Monday-Friday 8am-5:30pm.

24. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

25. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

8/19/07

C. LUKE GILLIGAN
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